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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,542	02/06/2002	Bo. T. Claridge	5007260-2	8006

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EXAMINER	
O'CONNOR, GERALD J	

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/068,542	Claridge et al.	
	Examiner	Art Unit	
	O'Connor	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *THREE* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *March 30, 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1, 4-12, and 29-31* is/are pending in the application.

4a) Of the above claim(s) *none* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 4-12, and 29-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *February 6, 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 30, 2006 has been entered.

Preliminary Remarks

2. This Office action responds to the amendment and arguments filed by applicant on March 30, 2006 in reply to the previous Office action on the merits, mailed November 30, 2005.

3. The amendment of claims 1, 6, 9, and 29 by applicant in the reply filed on March 30, 2006 is hereby acknowledged.

4. The cancellation of claims 13-28 by applicant in the reply filed on March 30, 2006 is hereby acknowledged.

5. The addition of claims 30 and 31 by applicant in the reply filed on March 30, 2006 is hereby acknowledged.

Claim Rejections - 35 USC § 112, Second Paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if the recited method step of "identifying investment-preference information" is intended to refer to the previously recited method step of "identifying, by the computer, investment-preference information," or else is referring to a second step of an additional identifying of investment-preference information, possibly by manual means.

Additionally, it is unclear how the "first" and "second" investment choices would be the first and second choices, since they are actually the second and third investment choices claimed, respectively.

Lastly, it is unclear how the claim could be "the method of claim 1," "comprising" the recited steps, as opposed to "further comprising" the recited steps, since dependent claims must include all limitations of the claim(s) from which they depend, to which base/parent claim limitations the dependent claim must add further, additional limitations.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1, 4-12, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (US 6,112,191), in view of Barton (US 6,164,533).

Burke discloses a method for effectuating an investment comprising the steps of: completing a point-of-sale transaction by a user at a point-of-sale location; receiving, by a computer, a request to complete an on-demand investment transaction; identifying, by the computer, investment-preference information associated with the user in response to receiving the request; and, causing, by the computer, funds relating to the investment amount to be transferred to an investment account. See, in particular, Figures 4A, 4B, and 4C. The disclosure of Burke, though, does not specifically teach that the investment-preference information includes any predetermined monetary investment amount for the on-demand investment, as the investment amount in the method of Burke is specified at the point-of-sale location at the time of the sale, nor does the disclosure of Burke include that the investment transaction occurs after completion of the point-of-sale transaction.

However, Barton discloses a similar method of investment, which method indeed includes that the investment-preference information includes a predetermined monetary investment amount for the on-demand investment. See, in particular, column 5, lines 44-50.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Burke so as to include in the investment-preference information a predetermined monetary investment amount for the on-demand investment, in accordance with the teachings of Barton, in order to assist a user in achieving a budgeted investment goal by suggesting a default investment amount with each purchase being made.

Regarding the investment transaction occurring *after completion* of the point-of-sale transaction (i.e., as a second, separate transaction), it would also have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the system of Burke, so as to split the processing steps/functions out into two separate transactions, such that the investment transaction would occur after completion of the point-of-sale transaction (i.e., as a second, separate transaction), in order to ensure that the "primary" "sale transaction" of the merchant would clear and be booked/processed successfully prior to attempting to charge additional funds to the customer's credit card for the "optional" "investment transaction," possibly thereby exceeding the credit limit of the customer's credit card, thus with only the second "optional" transaction failing to process, rather than with both transactions failing to process, since it is well settled that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Regarding claim 4, the method of Burke further comprises the step of temporarily accumulating the on-demand investment request until a predetermined completion time. See, in particular, column 3, lines 4-13.

Regarding claims 5-8, Burke does not disclose any investment limit/maximum, thus does not disclose accommodating an investment limit/maximum by including an investment total and a predetermined investment limit in the investment-preference information and, if the on-demand investment request would cause the limit/maximum to be exceeded, avoiding exceeding the maximum by either canceling the on-demand investment request or rolling the on-demand investment request over to a secondary/alternate investment account. However, Barton discloses a similar method of investment, which method indeed includes contributing the on-demand investment request to an investment account having a limit/maximum (an IRA). See, in particular, column 5, lines 44-50. Since canceling a deposit or rolling it over to a secondary/alternative account are self-evident and well known, hence obvious, steps to perform in order to avoid exceeding a limit/maximum of an investment account having a limit/maximum, such as an IRA, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Burke so as to invest in an account having an investment limit/maximum, in accordance with the teachings of Barton, and to accommodate the investment limit/maximum by not exceeding it, by including an investment total and a predetermined investment limit in the investment-preference information and, if the on-demand investment request would cause the limit/maximum to be exceeded, avoiding exceeding the maximum by either canceling the on-demand investment request or rolling the on-demand investment request over to a secondary or alternate investment account, as is self-evident and well known to do, in order to obey the law by complying with limits/maximums imposed on certain investment accounts, such as IRAs, by the

law, and since so-doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 9-11, the method of Burke comprises associating a purchasing account with an investment account and using either the purchasing account or a source other than the purchasing account to contribute to the investment account. See, in particular, column 12, lines 11-16.

Regarding claim 12, the method of Burke includes receiving, from the purchaser at the point-of-sale location, a request to specify the monetary investment amount. Therefore, the combination described above with respect to claim 1 would inherently include the step of receiving, from the purchaser at the point-of-sale location, a request to modify the predetermined monetary investment amount, since simply specifying an amount is equivalent to modifying a predetermined amount of zero to any non-zero amount.

Regarding claim 13, the method of Burke includes adding the investment amount to a transaction amount, during processing of a point-of-sale transaction. Therefore, the combination described above with respect to claim 1 would inherently include the step of adding the predetermined dollar investment amount to the transaction amount, during processing of the point-of-sale transaction.

Regarding claim 29, the method of Burke includes a first investment account and a second investment account and automatically contributes the investment to each account without regard to whether or not other attempts to other accounts failed.

Response to Arguments

10. Applicant's arguments filed March 30, 2006 have been fully considered but they are not deemed persuasive.

11. The arguments regarding the previous prior art rejections have been considered, but have been rendered moot by applicant's amendment, and the consequent new grounds of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to the disclosure.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Questions on access to the Private PAIR system should be directed to the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

14. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is (571) 273-6787.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at (571) 272-6771.

Official replies to this Office action may be submitted by any ***one*** of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC
June 12, 2006

6/12/06

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627